

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:) Mail Stop Appeal Brief - Patents
Craig L. REDING et al.)
Application No.: 10/720,920) Group Art Unit: 2614
Filed: November 24, 2003)
For: METHODS AND SYSTEMS FOR NOTIFICATION OF CALL TO DEVICE)))))

APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

This Appeal Brief is submitted in response to the Final Office Action mailed November 29, 2007 and in support of the Notice of Appeal filed February 28, 2008.

I. **REAL PARTY IN INTEREST**

The real party in interest of the present application, solely for purposes of identifying and avoiding potential conflicts of interest by board members due to working in matters in which the member has a financial interest, is Verizon Communications Inc. and its subsidiary companies, which currently include Verizon Business Global, LLC (formerly MCI, LLC) and Celco Partnership (doing business as Verizon Wireless, and

which includes as a minority partner affiliates of Vodafone Group Plc). Verizon Communications Inc. or one of its subsidiary companies is an assignee of record of the present application.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals, interferences or judicial proceedings.

III. STATUS OF CLAIMS

Claims 1-4 and 6-12 are pending in this application. Claims 5, 13, and 14 have been canceled without prejudice or disclaimer. Claims 1-4 and 6-12 have been rejected. Claims 1-4 and 6-12 are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the Final Office Action mailed November 29, 2007.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Each of the independent claims involved in this appeal is recited below, followed in parenthesis by examples of where support can be found in the specification and drawings for the claimed subject matter. In addition, each dependent claim argued separately below is also summarized in a similar manner.

Claim 1 recites: A method for providing a notification to a preferred communication device of a plurality of communication devices associated with a user, wherein each of the communication devices can be designated as the preferred communication device, the method comprising: receiving, at a server, a notification from one of the communication devices indicating that incoming data has been received at the one communication device (e.g., 710, 720, Fig. 7; page 39, lines 1-8); transmitting the received notification to the preferred communication device (e.g., 770, Fig. 7; page 39, lines 9-13); and receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device (e.g., page 33, lines 4-12).

Claim 4 recites: The method of claim 1, further comprising: receiving, at the server, a selection, made by the user, of a time period during which notifications are to be transmitted to the preferred communication device (e.g., page 33, lines 4-12).

Claim 9 recites: The method of claim 1, wherein the notification is a SMS message (e.g., page 8, line 22 – page 9, line 2).

Claim 10 recites: An apparatus for providing a notification to a preferred communication device of a plurality of communication devices which may be used by a user to initiate and receive communications, the apparatus comprising: a server (e.g., 406, Fig. 5) configured to: receive a notification from one of the communication devices indicating that incoming data has been received at the one communication device (e.g.,

710, 720, Fig. 7; page 39, lines 1-8); transmit the notification to the preferred communication device, the notification including an identification of the type of the incoming data (e.g., 770, Fig. 7; page 34, line 20 – page 35, line 5; page 39, lines 9-13); and receive a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device (e.g., page 33, lines 4-12).

Claim 12 recites: The apparatus of claim 11, wherein the database indicates times during which notifications are to be transmitted to the preferred communication device (e.g., page 33, lines 4-12).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3, 6-8, 10, and 11 have been rejected under 35 U.S.C. § 102(e) as being anticipated by LAZARIDIS et al. (U.S. Patent No. 6,463,464 B1); claims 4 and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over LAZARIDIS et al. in view of LEE et al. (U.S. Patent No. 6,161,008); and claim 9 has been rejected under 35 U.S.C. § 102(e) as being anticipated by LAZARIDIS et al. or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over LAZARIDIS et al. in view of SKIDMORE (U.S. Patent Application Publication No. 2003/0036380) or in view of TRAN et al. (U.S. Patent No. 6,154,646).

VII. ARGUMENT

A. The rejection under 35 U.S.C. § 102 based on LAZARIDIS et al. should

be reversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention. Any feature not directly taught must be inherently present. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987).

1. Claims 1-3 and 6-9

Claim 1 recites a method for providing a notification to a preferred communication device of a plurality of communication devices associated with a user, wherein each of the communication devices can be designated as the preferred communication device. The method includes receiving, at a server, a notification from one of the communication devices indicating that incoming data has been received at the one communication device; transmitting the received notification to the preferred communication device, and receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device. LAZARIDIS et al. does not disclose or suggest this combination of features.

For example, LAZARIDIS et al. does not disclose or suggest receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device. The Examiner relies on column 2, lines 58-65; column 7, lines 11-14; column 8, lines 6-9 and

43-55; and column 9, lines 26-58 of LAZARIDIS et al. as allegedly disclosing this feature (final Office Action, pp. 4-5). Appellants respectfully disagree with the Examiner's interpretation of LAZARIDIS et al.

At column 2, lines 58-65, LAZARIDIS et al. discloses:

As used in this application, the term host system refers to the computer where the redirector software is operating. In the preferred embodiment of the present invention, the host system is a user's desktop PC, although, alternatively, the host system could be a network server connected to the user's PC via a local-area network ("LAN"), or could be any other system that is in communication with the user's desktop PC.

This section of LAZARIDIS et al. discloses that a host system can be a network server connected to the user's PC via a local-area network. Though this section of LAZARIDIS et al. mentions a "server," this section of LAZARIDIS et al. does not disclose or suggest receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device, as recited in claim 1.

At column 7, lines 11-14, LAZARIDIS et al. discloses that a mobile device can optionally send a command message to the host system to receive more or all of a data item if only a portion of the data item is transmitted to the mobile device in order to minimize the amount of data transmitted via the wireless device. More specifically, this section of LAZARIDIS et al. discloses giving a user the option to receive the remainder of a message if only a portion of the message is sent. This section of LAZARIDIS et al. does not disclose or suggest receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device, as recited in claim 1.

At column 8, lines 6-9, LAZARIDIS et al. discloses that the redirector may be programmed with a preferred list mode that is configured by the user either at the host system or remotely from the user's mobile data communication device by transmitting a command message. The preferred list contains a list of senders whose messages are to be redirected or a list of message characteristics that determine whether a message is to be redirected. Thus, this section of LAZARIDIS et al. merely discloses redirecting select messages. This section of LAZARIDIS et al. does not mention another one of the communication devices for which notifications are to be transmitted to the preferred communication device. Therefore, this section of LAZARIDIS et al. cannot disclose or suggest receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device, as recited in claim 1.

At column 8, lines 43-55, LAZARIDIS et al. discloses:

In the preferred embodiment this method is to send the message A back over the LAN 14, WAN 18, and through the wireless gateway 20 to the mobile data communication device 24. In doing so, the redirector preferably repackages message A as an E-mail with an outer envelope B that contains the addressing information of the mobile device 24, although alternative repackaging techniques and protocols could be used, such as a TCP/IP repackaging and delivery method (most commonly used in the alternative server configuration shown in FIG.2). The wireless gateway 20 requires this outer envelope information B in order to know where to send the redirected message A.

This section of LAZARIDIS et al. discloses redirecting a message by repackaging a message as an e-mail with an outer envelope that contains the addressing information of a mobile device. This section of LAZARIDIS et al. does not mention another one of the communication devices for which notifications are to be transmitted to the preferred

communication device. Therefore, this section of LAZARIDIS et al. cannot disclose or suggest receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device, as recited in claim 1.

At column 9, lines 26-58, LAZARIDIS et al. discloses:

FIG. 2 is an alternative system diagram showing the redirection of user data items from a network server 11 to the user's mobile data communication device 24, where the redirector software 12 is operating at the server 11. This configuration is particularly advantageous for use with message servers such as Microsoft's® Exchange Server, which is normally operated so that all user messages are kept in one central location or mailbox store on the server instead of in a store within each user's desktop PC. This configuration has the additional advantage of allowing a single system administrator to configure and keep track of all users having messages redirected. If the system includes encryption keys, these too can be kept at one place for management and update purposes.

In this alternative configuration, server 11 preferably maintains a user profile for each user's desktop system 10, 26, 28, including information such as whether a particular user can have data items redirected, which types of message and information to redirect, what events will trigger redirection, the address of the users' mobile data communication device 24, the type of mobile device, and the user's preferred list, if any. The event triggers are preferably detected at the user's desktop system 10, 26, 28 and can be any of the external, internal or network events listed above. The desktop systems 10, 26, 28 preferably detect these events and then transmit a message to the server computer 11 via LAN 14 to initiate redirection. Although the user data items are preferably stored at the server computer 11 in this embodiment, they could, alternatively, be stored at each user's desktop system 10, 26, 28, which would then transmit them to the server computer 11 after an event has triggered redirection.

This section of LAZARIDIS et al. discloses the redirection of user data items from different user desktop systems connected to a network server to different users' mobile data communication devices. A desktop system detects an event and transmits a message to the server computer to initiate redirection to the mobile data communication device

associated with the user of the desktop system. This section of LAZARIDIS et al. discloses transmitting a message from a user's desktop to a user's mobile data communication device via a server. This section of LAZARIDIS et al. does not mention another communication device for which notifications are to be transmitted to the preferred communication device. Therefore, this section of LAZARIDIS et al. cannot disclose or suggest receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device, as recited in claim 1.

In response to Appellants' assertions that LAZARIDIS et al. discloses that a preferred list contains a list of message characteristics that determine whether a message is to be redirected and does not disclose or suggest another communication device for which notifications are to be transmitted to the preferred communication device, the Examiner alleges:

The message inherently includes a destination device address i.e. IP (Internet Protocol) address of device on Internet or a MAC (Media Access Control) address of a device on an Ethernet, to which the message is delivered. It is inherent to use this destination device address characteristic of a message, the selection of which is indicated by the user to the server, for alternate routing or forwarding for delivery of the message. If the system were to redirect the messages based only on the sender, then all messages from a particular sender redirected to different devices of different users would be forcibly redirected to only one device irrespective of the devices selected by the recipients. Thus, it is inherent to use the destination device address characteristic of the message as selected by the user to determine the redirection of the message

(final Office Action, pg. 3). Appellants respectfully disagree with the Examiner's allegation. LAZARIDIS et al. discloses pushing data items from a host system (a user's desktop PC or a network server connected to the user's PC) to a user's mobile data

communication device upon detecting the occurrence of one or more user-defined event triggers (column 2, lines 53-57). If a user were to route messages from the host system based on the destination address of a message, as suggested by the Examiner, then all messages sent to the user's PC (which would all include the destination address of the user's PC) would be forwarded to the user's mobile data communication device, which is the opposite of pushing user-selected data items, as disclosed by LAZARIDIS et al. (column 2, lines 28-31).

Regardless of the Examiner's allegation that the destination device address may be used as a message characteristic that determines whether a message is to be redirected, LAZARIDIS et al. discloses redirecting data from a host system to a user's mobile data communication device and does not mention another communication device for which notifications are to be transmitted to a preferred communication device. Therefore, LAZARIDIS et al. does not disclose or suggest receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device, as recited in claim 1.

In response to the above remarks, in the Advisory Action the Examiner alleges that LAZARIDIS et al. "clearly teaches that the user defines different triggers (selection made by the user) and each trigger includes device address (another communication device) for which redirection is to take place, trigger event causing redirection and data (messages) to be redirected, and storing the information about the communication device (preferred communication device) to which data is redirected," and relies on column 12, lines 1-45 of LAZARIDIS et al. for support. Appellants respectfully disagree with the Examiner's allegation.

At column 12, lines 1-45, LAZARIDIS et al. discloses the initial configuration steps of the redirector program when it is operating at a desktop system and the additional configuration steps to enable redirection of a desktop system connected to a server. This section of LAZARIDIS et al. discloses only one communication device from which data is to be transferred to a preferred communication device. In fact, this section of LAZARIDIS et al. explicitly states that additional configuration steps may be necessary to enable redirection for a particular desktop system connected to a server. Therefore, LAZARIDIS et al. clearly recites transmitting data received at one communication device, not receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device, as recited in claim 1.

For at least the foregoing reasons, Appellants submit that the rejection of claim 1 under 35 U.S.C. § 102(e) based on LAZARIDIS et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claims 2, 3, and 6-9 depend from claim 1. Therefore, Appellants request that the rejection of these claims be reversed for at least the reasons given above with respect to claim 1.

2. Claims 10 and 11

Claim 10 recites an apparatus for providing a notification to a preferred communication device of a plurality of communication devices which may be used by a user to initiate and receive communications. The apparatus includes a server configured to: receive a notification from one of the communication devices indicating that incoming

data has been received at the one communication device; transmit the notification to the preferred communication device, the notification including an identification of the type of the incoming data; and receive a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device. LAZARIDIS et al. does not disclose or suggest this combination of features.

For example, LAZARIDIS et al. does not disclose or suggest a server configured to receive a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device. The Examiner relies on column 2, lines 58-65; column 7, lines 11-14; column 8, lines 6-9 and 43-55; and column 9, lines 26-58 of LAZARIDIS et al. as allegedly disclosing this feature (final Office Action, pp. 4-6). For reasons similar to the reasons given above with respect to claim 1, Appellants submit that LAZARIDIS et al. does not disclose or suggest the above feature of claim 10. Therefore, Appellants submit that the rejection of claim 10 under 35 U.S.C. § 102(e) based on LAZARIDIS et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 11 depends from claim 10. Therefore, Appellants request that the rejection of these claims be reversed for at least the reasons given above with respect to claim 10.

B. The rejection under 35 U.S.C. § 103 based on LAZARIDIS et al. and LEE et al. should be reversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been realistically motivated to modify an applied reference and/or combine applied references to arrive at the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

In establishing the requisite motivation, it has been consistently held that the requisite motivation to support the conclusion of obviousness is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in the art to modify a reference or to combine references with a reasonable expectation of successfully achieving some particular realistic objective. See, for example, Interconnect Planning Corp. v. Feil, 227 USPQ 543 (Fed. Cir. 1985). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. Carella v. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

1. Claim 4

Claim 4 depends from claim 1. Without acquiescing in the Examiner's rejection of claim 4, Appellants submit that the disclosure of LEE et al. does not remedy the deficiencies in the disclosure of LAZARIDIS et al. set forth above with respect to claim

1. Therefore, Appellants submit that the rejection of claim 4 under 35 U.S.C. § 103(a) based on LAZARIDIS et al. and LEE et al. is improper. Accordingly, Appellants request that the rejection be reversed.

2. Claim 12

Claim 12 depends from claim 10. Without acquiescing in the Examiner's rejection of claim 12, Appellants submit that the disclosure of LEE et al. does not remedy the deficiencies in the disclosure of LAZARIDIS et al. set forth above with respect to claim 10. Therefore, Appellants submit that the rejection of claim 12 under 35 U.S.C. § 103(a) based on LAZARIDIS et al. and LEE et al. is improper. Accordingly, Appellants request that the rejection be reversed.

C. The rejection under 35 U.S.C. § 103 based on LAZARADIS et al. and SKIDMORE should be reversed.

Claim 9

Claim 9 depends from claim 1. Without acquiescing in the Examiner's rejection of claim 9, Appellants submit that the disclosure of SKIDMORE does not remedy the deficiencies in the disclosure of LAZARIDIS et al. set forth above with respect to claim 1. Therefore, Appellants submit that the rejection of claim 9 under 35 U.S.C. § 103(a) based on LAZARIDIS et al. and SKIDMORE is improper. Accordingly, Appellants request that the rejection be reversed.

D. The rejection under 35 U.S.C. § 103 based on LAZARIDIS et al. and TRAN et al. should be reversed.

Claim 9

Claim 9 depends from claim 1. Without acquiescing in the Examiner's rejection of claim 9, Appellants submit that the disclosure of TRAN et al. does not remedy the deficiencies in the disclosure of LAZARIDIS et al. set forth above with respect to claim 1. Therefore, Appellants submit that the rejection of claim 9 under 35 U.S.C. § 103(a) based on LAZARIDIS et al. and TRAN et al. is improper. Accordingly, Appellants request that the rejection be reversed.

VIII. CONCLUSION

In view of the foregoing arguments, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections of claims 1-4 and 6-12.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the

filng of this paper, including extension of time fees, to Deposit Account 50-1070 and
please credit any excess fees to such deposit account.

Respectfully submitted,

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IX. APPENDIX

1. A method for providing a notification to a preferred communication device of a plurality of communication devices associated with a user, wherein each of the communication devices can be designated as the preferred communication device, the method comprising:

receiving, at a server, a notification from one of the communication devices indicating that incoming data has been received at the one communication device; transmitting the received notification to the preferred communication device; and receiving, at the server, a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device.

2. The method of claim 1, wherein transmitting the notification to the preferred communication device comprises storing the notification in a database if the preferred communication device cannot receive the notification.

3. The method of claim 1, further comprising:
selecting the preferred communication device from among the plurality of communication devices.

4. The method of claim 1, further comprising:

receiving, at the server, a selection, made by the user, of a time period during which notifications are to be transmitted to the preferred communication device.

5. (canceled)

6. The method of claim 1, further comprising:
receiving, at the server, a selection, made by the user, of one or more calling parties from which notifications are to be transmitted to the preferred communication device.

7. The method of claim 6, wherein receiving the selection is based on a calendar function for providing date specific notifications.

8. The method of claim 1, further comprising:
receiving, at the server, a selection, made by the user, of the preferred communication device for receiving notifications based on the time of day or a calling party.

9. The method of claim 1, wherein the notification is a SMS message.

10. An apparatus for providing a notification to a preferred communication device of a plurality of communication devices which may be used by a user to initiate

and receive communications, the apparatus comprising:

 a server configured to:

 receive a notification from one of the communication devices indicating that incoming data has been received at the one communication device;

 transmit the notification to the preferred communication device, the notification including an identification of the type of the incoming data; and

 receive a selection, made by the user, of another one of the communication devices for which notifications are to be transmitted to the preferred communication device.

11. The apparatus of claim 10, further comprising:

 a database configured to select calling parties from which notifications are to be transmitted to the preferred communication device.

12. The apparatus of claim 11, wherein the database indicates times during which notifications are to be transmitted to the preferred communication device.

13. (canceled)

14. (canceled)

X. EVIDENCE APPENDIX

None

XI. RELATED PROCEEDINGS APPENDIX

None